



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,575	08/16/2001	Scott G. Newnam	109779.133	2412
23483	7590	10/27/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,575	NEWNAM ET AL.	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/15/02, 5/28/02, 7/23/03, 3/29/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are presented for examination.

Objections

2. Claim 11 is objected to because of the following informalities: Claim 11 states, "device are," instead of "devices are." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

3. Claim 1 is rejected under 35 U.S.C. 112.

Claim 1 teaches a **method** for enhancing a broadcast event **comprising: a server system** providing **content** related to the broadcast event to remote users having local devices that can interpret **content** and process **messages** received from the server system to cause **information** to be displayed. As recited, it is unclear if **content** is the advertisement/supplemental data and is the same thing as **information**. Additionally, it is unclear if the applicant means a **method** or a **system** for enhancing an event, since the applicant says a **method comprising a server system**. The claim continues by stating **during the broadcast event**, the server system providing to the local devices messages that cause the local devices to display the content. It is unclear if this means that former part of the claim does or does not take place **during the broadcast event**. The claim

Art Unit: 3622

continues by stating wherein each of the content and messages are provided at the same time to **at least two different types of local devices, including two or more of personal computers**, set top boxes, net top boxes, **wireless computers**, consoles, and **hand-held computers**. This confusing and unclear, since it says **at least two** and then says **two or more** personal computers, it is unclear if this means that **at least two** personal computers have to be selected and one more type of local device other than a personal computer have to be selected. Furthermore, wireless computers, hand-held computers, and personal computers can all be the same thing, so it is unclear what is the applicant trying to claim here. Due to several deficiencies in claim 1 as recited above, examiner interprets that the claim means **content** is advertisements/supplemental data/surveys, which is the same thing as **information** as recited in the claim. Examiner further interprets that claim 1 in its entirety is to be viewed in the context of **during the broadcast event**. Additionally, Examiner interprets **two different types of local devices** to be a set-top box hooked up to a television and any computing device such as a personal computer, a hand-held computer, or a wireless computer, since they are all computers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3622

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6, 8, 10-14, 17-19, and 22 are rejected under 102(a) as being anticipated by Bendinelli et al (Patent Number 6,061,719 hereinafter Bendinelli).

In reference to claim 1, Bendinelli discloses a method for enhancing a broadcast event comprising: a server system providing content related to the broadcast event to remote users having local devices that can interpret content and process messages received from the server system to cause information to be displayed (col. 2 lines 9-13, col. 5 lines 27-37, col. 5 lines 63 to col. 6 lines 2, and Figure 3); and during the broadcast event, the server system providing to the local devices messages (URLs) that cause the local devices to display the content (col. 3 lines 16-29, col. 6 lines 12-31, and Figures 2-4); wherein each of the content and messages are provided at the same time to at least two different types of local devices, including two or more of personal computers, set top boxes, net top boxes, wireless computers, consoles, and hand held computers (abstract, col. 5 lines 58 to col. 6 lines 11, col. 6 lines 31-39, and Figure 4).

5. In reference to claim 2, Bendinelli discloses a method wherein the content and messages are sent via Internet Protocol (col. 5 lines 19-32, col. 5 lines 58 to col. 6 lines 11, col. 6 lines 31-39, and Figures 3 and 4).

6. In reference to claim 3, Bendinelli discloses a method further comprising, in response to an advertisement being broadcast, the server system selecting one additional advertisement from a plurality of different advertisements tailored to different users, the one advertisement being related to, and for display at the

Art Unit: 3622

same time as, the broadcast advertisement (col. 3 lines 13-29, col. 5 lines 37-47, col. 6 lines 4-11, and lines 31-36, and Figures 1, 3, and 4).

7. In reference to claim 6, Bendinelli discloses a method wherein the broadcast event is broadcast over television, radio, and/or the Internet (col. 5 lines 33-45, col. 6 lines 2-8, and lines 31-36, and Figures 1, 3, and 4).

8. In reference to claim 8, Bendinelli discloses a method further comprising transmitting the interactive content before the broadcast event begins (col. 5 lines 50-54 and col. 6 lines 15-31).

9. In reference to claim 10, Bendinelli discloses a method wherein the messages do not include Internet addresses but are sent at the same time as Internet addresses that are used for accessing web pages with similar content, the local devices displaying content in response to the messages and not using the Internet addresses on receiving a message (col. 6 lines 12-27).

10. In reference to claim 11, Bendinelli discloses a method wherein at least two of the different types of local devices are programmed to display interactive content in a manner different from each other in terms of size and/or location of content on a display (col. 5 lines 33- 37-47, col. 6 lines 1-6 and lines 31-36, and Figures 1, 3, and 4).

11. In reference to claim 12, Bendinelli discloses a method wherein the broadcast content is displayed and the broadcast content and the interactive content are provided on the same display in different windows (col. Col. 5 lines 37-40, col. 6 lines 31-36, and Figures 3).

Art Unit: 3622

12. In reference to claim 13, Bendinelli discloses a method wherein the broadcast content is displayed and the broadcast content and the interactive content are provided on the separate displays (col. 5 lines 58 to col. 6 lines 11 and Figure 4).

13. In reference to claim 14, Bendinelli discloses a method wherein the interactive content includes content applicable to multiple broadcast events for display during the event, and the content applicable to specific events for display during the respective specific event (col. 3 lines 21-29).

14. In reference to claim 17, Bendinelli discloses a method wherein the server system determines the type of local device and provides information in response to that determination (col. 5 lines 27 to col. 6 lines 36, and Figures 3 and 4).

15. In reference to claim 18, Bendinelli discloses a method wherein a first type of local device is programmed to use the content from the server system in one manner and a second type of local device is programmed to use the content from the server system in another manner (col. 5 lines 41-57, col. 6 lines 31-36, col. 4 lines 23-36, lines 47-53, and lines 64-67, and Figures 2-4).

16. In reference to claim 19, Bendinelli discloses an interactive system including a server system for providing to local users messages and content related to a broadcast event (col. 2 lines 9-13, col. 5 lines 27-37, col. 5 lines 63 to col. 6 lines 2, and Figure 3), the server system maintaining multiple local advertisement messages directed toward different users or groups of users (col. 3 lines 21-31), the server system responsive to an advertisement being broadcast with the broadcast event, for selecting one of a plurality of the local

Art Unit: 3622

advertisements and for causing that advertisement to be displayed additionally to the user at the same time as the advertisement in the broadcast event (col. 3 lines 13-29, col. 5 lines 37-47, col. 6 lines 4-11, and lines 31-36, and Figures 1, 3, and 4).

17. In reference to claim 22, Bendinelli discloses the system wherein the selected local advertisement is provided to a computer and the broadcast event is to a television (col. 3 lines 21-31, col. 5 lines 58 to col. 6 lines 11, and Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 5, 20, and 21 are rejected under U.S.C. 103(a) as being unpatentable over Bendinelli in view of Stewart et al (6,414,635 hereinafter Stewart).

In reference to claims 4 and 21, Bendinelli does not teach the method further comprising maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles. Stewart teaches the method further comprising maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles (col. 10 lines 8-20 and col. 13 lines 36-54). It would have been obvious

Art Unit: 3622

to modify Bendinelli to include maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles to better target advertisements to users based on user preferences.

19. In reference to claims 5 and 20, Bendinelli does not teach the method wherein the server system selects the one additional local advertisement based on the user's location. Stewart teaches the method wherein the server system selects the one additional local advertisement based on the user's location (col. 5 lines 18-24 and col. 13 lines 36-54). It would have been obvious to modify Bendinelli to include the server system selecting the one additional local advertisement based on the user's location to deliver better targeted advertisements to users based on whether the user is at home, hotel, or a gym for example that will be more relevant to the user based on the user's location at the time of the broadcast.

20. Claims 7 and 9 are rejected under U.S.C. 103(a) as being unpatentable over Bendinelli in view of Barton et al (6,233,389 hereinafter Barton).

In reference to claims 7 and 9, Bendinelli teaches the method further comprising transmitting the interactive content to the local device while the event is occurring (col. 3 lines 13-29, col. 5 lines 37-47, col. 6 lines 4-11, and lines 31-36, and Figures 1, 3, and 4). Bendinelli does not teach storing and downloading this content for later display in response to a message after the content has been transmitted. Barton teaches storing and downloading this content for later display in response to a message after the content has been transmitted by using a multimedia time warping system, also known as TIVO (abstract, col. 1 lines 63

Art Unit: 3622

to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). It would have been obvious to modify Bendinelli to include a system that can store content for later display in response to a message after the content has been transmitted to enable the user to view the content at a time that is convenient for the user and not dictated by the time of the original broadcast.

21. Claims 15 and 16 are rejected under U.S.C. 103(a) as being unpatentable over Bendinelli in view of Barton et al (6,233,389 hereinafter Barton) and further in view of Official Notice.

In reference to claim 15, Bendinelli does not teach the method wherein at least some of the local devices include a recording device for receiving and storing the broadcast event, the content, and the messages and associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast.

Barton teaches the method wherein at least some of the local devices include a recording device for receiving and storing the broadcast event, the content, and the messages (abstract, col. 1 lines 63 to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). Barton is silent about associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast. Official notice is taken that is well known to present interactive content in a playback environment such as when a user plays a game in a playback mode and the user does not get to find out the answers to

Art Unit: 3622

the game questions until the end of the game. Additionally, it is well known that if the broadcast includes an associated URL, the URL will be retrieved accordingly at that time in a re-broadcast of the original event. It would have been obvious to modify Bendinelli to include a method wherein at least some of the local devices include a recording device for receiving and storing the broadcast event, the content, and the messages and associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast to enable users to view the content at a convenient time without losing the feel of the real-time interactive nature of the invention.

22. In reference to claim 16, Bendinelli does not teach the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data. Official notice is taken that it is well known for interactive playback storage devices to present follow-on content in response to a user entering data during a playback of a broadcast event as done when a user is presented a survey to complete and will receive the follow on content of survey results only after the user completes the survey in the playback environment. It would have been obvious to modify Bendinelli to include the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data to maintain the interactive and real-time feel of a

Art Unit: 3622

previously broadcasted program for the user and to maintain the surprise of aggregate results until the user has provided his/her input by completing the survey.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Huang Publication Number US 2002/0103696 A1. Teaches a system and method for interactive voting using a computer network.
- b) Shoff Publication Number US 2001/0001160 A1. Teaches an interactive entertainment system for presenting supplemental interactive content together with continuous video programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105. On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

October 24th, 2005

Yehdega Retta
RETTA YEHDEGA
PRIMARY EXAMINER